

REMARKS/ARGUMENT

Claims 1-42, 61-63, and 67 are pending. Claims 1-6, 8-13, 15-19, 23-36, 38-41, and 61-63 have been amended. Claim 67 has been added. Claims 43-60 were previously cancelled without prejudice in response to an earlier restriction requirement. Claims 64-66 are presently cancelled without prejudice in response to an additional restriction requirement. No new matter has been added.

Support for the claim amendments can be found, for example, in paragraphs [0033]-[0036], [0040], and [0046]-[0049] of pre-grant publication no. US 2004/0153408.

Election Restriction

Claims 64-66 are subject to restriction and/or election requirement. The Applicants have canceled these claims without prejudice to advance prosecution of the subject application.

Claim Rejections – 35 U.S.C. 103(a)

Claims 1-42 and 61-63 are rejected as being unpatentable over U.S. Patent No. 6,363,164 (“Jones”) in view of U.S. Patent No. 4,774,663 (“Musmanno”) and the Applicant’s specification. These rejections are respectfully traversed.

Independent Claim 1

Amended independent claim 1 recites, *inter alia*, (1) “automatically generating a government-required report whenever the accumulated total value exceeds a prescribed value,” and (2) “the automatically generated government-required report comprising one or more of the electronic images.”

The Office Action states that Jones does not teach “automatically generating a government-required report whenever the accumulated total value exceeds a prescribed value.” (Office Action, at 4). The Office Action further states that Jones does not teach automatically generating a report to include complete images of currency bills included in a deposit. (Office Action, at 6). Neither Musmanno nor the Office Action’s improper reliance on the Applicants’ specification overcome the stated shortcomings of Jones.

Musmanno fails to disclose or suggest an automatically generated government-required report, as recited in claim 1. Rather, Musmanno discloses a regular business-type report is printed when one of the tests 37, 39 is answered in the affirmative. The tests 37, 39 look at historical transactional data for a customer and flag possible system abuses, such as check kiting activities. That is, the report disclosed in Musmanno is directed to satisfying a business requirement and not a government requirement. Furthermore, Musmanno fails to suggest automatically generating its business-type report. Rather, Musmanno merely states that, “[i]f either of the tests 37 or 39 is answered in the affirmative, an output report is printed 40 to signal the incidence as a matter for investigation.” (column 4, line 68 to column 5, line 3). It is noteworthy that Musmanno fails to disclose any specific computer, processor, device, machine, or apparatus configured to or capable of automatically generating and/or printing the report. That is, the printing of the output report in Musmanno is apparently caused by a person reviewing the historical transactional data and based on tests 37, 39, and manually printing the report for further investigating the potential fraud. *See generally* Musmanno. For at least these reasons Musmanno does not account for the stated shortcomings of Jones.

In addition, Musmanno fails to disclose or suggest the automatically generated government-required report comprising one or more of the electronic images, as recited in claim 1. In an attempt to overcome the stated shortcomings of Jones and Musmanno, the Office Action appears to impermissibly rely on hindsight by relying on Applicants’ admitted prior art. Furthermore, the Office Action fails to provide any citation to the apparent admitted art relied upon. Assuming *arguendo* that the Office Action is referring to the “Description of the Related Art” and furthermore that it were proper to rely on the Applicants’ specification (a position that the Applicants refute), there is no disclosure of automatically generating a report comprising one or more electronic images. Rather, the “Description of the Related Art” section recites *inter alia* “laws typically specify the type of information to be included in such reports” and the great need to have a system that is capable of monitoring all deposits made at a financial institution and automatically generating the required report. That is, the “Description of the Related Art” appears to recite one of the problems solved by the claimed invention. That is, the Applicants’ specification note deficiencies in the related art.

For at least these reasons, the cited prior art references do not and cannot disclose or suggest amended claim 1. Thus, the rejection of amended claim 1 and its respective dependent claims should be withdrawn, and the claims should be allowed.

Independent Claims 12, 23, and 32

Amended claim 12 recites, *inter alia*, “a generating device for automatically generating a government-required report whenever the accumulated total value exceeds a prescribed value, the automatically generated government-report including one or more of the electronic images.”

Amended claim 23 recites, *inter alia*, “a processor programmed to accumulate the total value of the at least one currency bill included in the deposit transaction, and to automatically generate a government-required report whenever the accumulated total value exceeds a prescribed value, the automatically generated government-required report containing one or more of the electronic images”.

Amended claim 32 recites, *inter alia*, “automatically generating and printing a government-required report whenever the accumulated total value exceeds a prescribed value, the automatically generated government-required report including at least a portion of the stored electronic data representing one or more of the at least partial video images”.

For at least similar reasons discussed above for amended claim 1, the cited prior art references do not and cannot disclose or suggest amended independent claims 12, 23, and 32. Thus, the rejection of claims 12, 23, 32, and their respective dependent claims should be withdrawn, and the claims should be allowed.

CONCLUSION

The Applicants submit that claims 1-42, 61-63, and 67 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

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It is believed that no additional fees are due; however, should any fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000381USPT.

Respectfully submitted,

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